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Appln. No.: 09/399,753

Amendment dated October 31, 2003

Reply to Office Action of August 20, 2003

### REMARKS

The office action of August 20, 2003 has been carefully reviewed and these remarks are responsive thereto. Claims 14-42 remain in this application. Claims 14, 15, 16 and 26 have been amended. Reconsideration and allowance of the instant application are respectfully requested based upon the above amendments and the following arguments.

#### Claim Rejections

##### **Rejections Based on *Ludwig et al.***

Claims 14-15, 18-19, and 25-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig et al.*, U.S. Pat. No. 5,854,893 [hereinafter referred to as *Ludwig*]. With respect to claim 14 (and those claims that depend from claim 14), in the previous Final Office Action dated March 6, 2003, the Final Office Action indicated that Applicants had not set forth in the claims a feature that would make the claims patentably distinct from the *Ludwig* reference. In particular, Examiner stated:

[I]t appears that Applicant's invention is a system in which client users select tools provided by a central 'tool provider' network node. This central node eliminates the need for the individual tools to be installed on each computer. This is not set forth in the claims . . . . Applicant's claim language does not make clear that these tools are provided only at a central 'tool provider' network node, or who does the 'predefinition.'

See Final Office Action dated March 6, 2003, p. 8-9. Applicants have amended claim 14 to point out with greater particularity the nature of the claimed invention. Specifically, Applicants have amended the claim in such a way as to demonstrate that the tools do not require a stand-alone installation on the client computer. The cited reference, *Ludwig*, does not teach, suggest, or disclose selecting a plurality of web-accessible tools from a list of available web-accessible tools wherein the selected web-accessible tools are provided at least through a web-based interface. As a result, claim 14 is allowable over *Ludwig*. Independent claim 26 has been similarly

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amended to point out with greater particularity the claimed invention. As a result, claim 26 is also allowable over *Ludwig*.

Claims 15, 18-19, and 25 are dependent from claim 14. For the same reasons outlined above, Applicants submit that these claims are also allowable over *Ludwig* as being dependent on an allowable base claim.

**Rejections Based on *Ludwig* in view of *Walker***

The Office Action rejected claims 16-17, 27-31 and 33-38 (all dependent from claim 14) as unpatentable over *Ludwig* in view of *Walker*, U.S. Pat. No. 6,240,396 [hereinafter *Walker*]. With respect to claim 16, the Office Action stated that each of the features described in claim 14 was present in *Ludwig* with the exception of a group identifier and description. The Office Action further stated that it would have been obvious to one of ordinary skill in the art at the time of invention to have provided a group identifier and description to users because it would have allowed a user to locate and confirm identity of groups in which he or she might wish to participate. The Office Action further alleged that with respect to claim 16, *Walker* discloses advertising for prospective participants at Col. 2, lines 1-19.

A prima facie case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). Because *Walker* teaches away from the claimed invention, the rejection of claim 16, as amended, is respectfully traversed. Although *Walker* does disclose advertising for prospective participants, it does so to demonstrate the problems inherent in the prior art:

Resellers may rely on classified advertisements in the newspaper, electronic bulletin boards, established contacts or "chat rooms" on the Internet . . . . A number of shortcomings, however, exist for both buyers and sellers in the present resale market. First, the aforementioned methods of advertising are generally neither efficient nor flexible. The cost of advertising often outweighs the marginal profit gained through advertising. For instance, an advertiser may pay \$30 for a classified ad that results in an additional profit of only \$15. Moreover, advertisements are difficult to remove from the public realm once tickets are resold....

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Further, advertising is especially difficult because many transactions need to be completed just before an event occurs.

*Walker* col. 1, line 62 through col. 2, line 14. Clearly, *Walker* discourages the use of advertisement for prospective participants and presents an alternative to doing so. In discouraging such use, *Walker* teaches away from the invention claimed in claim 16. Accordingly, for at least this reason, claim 16 is allowable over the combination of the *Ludwig* and *Walker* references.

Claim 27 was also rejected under 35 U.S.C. § 103(a) as obvious over *Ludwig* in view of *Walker*. The office action alleges that *Ludwig* discloses the invention substantially as claimed. It further states that steps 4-8 as set forth in claim 27 are disclosed in *Walker* and that it would have been obvious to combine the negotiation method steps in *Walker* with the method disclosed in *Ludwig* because doing so would facilitate a "haggling type negotiation" disclosed in *Walker*. Applicants respectfully traverse for at least the following reasons. *Walker* fails to teach, suggest, or disclose at least the steps of (6) researching responses, and (7) negotiating to accept a response.

Claim 27 recites in relevant part:

The method of claim 14, wherein the plurality of web-accessible tools provide for negotiating a deal over the plurality of computers, and the method further comprises:

- (4) posting on the web page an electronic list of information regarding one or more offers to form a contract;
- (5) posting on the electronic list one or more responses to the one or more offers;
- (6) researching the one or more responses to determine whether they satisfy one or more contract criteria;
- (7) negotiating over the network between at least two parties to accept or modify one or more of the responses; and
- (8) electronically signing a document to consummate the contract.

The method disclosed in *Walker* basically works in the following manner: A person interested in purchasing a ticket for an event posts the highest price they'd be willing to pay for a seat in the form of a binding offer to buy. The offer is posted on the network where prospective sellers view the offer to buy, and accept the offer if the terms are satisfactory. Likewise, a person who is interested in selling a ticket can post an offer to sell at a particular price. A buyer can

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immediately accept the offer to sell. There is no mechanism disclosed in which negotiation takes place. All offers are either accepted or rejected. Thus, in the system disclosed in *Walker*, the only response that will be communicated with respect to an offer to buy or sell a ticket will be an acceptance by another party. Because the only response that occurs in *Walker* is an actual acceptance, there is never a need to research a response to an offer to form the contract as recited in step 6 of claim 27. Moreover, because the responses to the offers are limited to acceptances of the offers, *Walker* fails to disclose negotiating over the network between the parties to accept or modify the responses as recited in step 7 of claim 27. Accordingly, claim 27 is allowable over *Ludwig* in view of *Walker*. Claims 28-31 and 33-36 all depend from claims 14 and 27 (either directly or indirectly), and in addition to being allowable based on their dependency on allowable base claim 14, are allowable for at least the same reasons as provided immediately above. Claim 17 also depends from allowable claim 14. The deficiencies of *Ludwig* with respect to this claim are not cured by *Walker*. Thus, claim 17 is also allowable.

#### **Rejections Based on *Ludwig* in view of *Ferguson***

Claims 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* in view of *Ferguson*, U.S. Pat. No. 5,995,951 [hereinafter *Ferguson*]. Applicants submit that claims 20-23 are allowable as based on allowable claim 14. In addition, *Ferguson* does not cure the deficiencies in *Ludwig* identified above. Claims 20-23 are therefore allowable over *Ludwig* in view of *Ferguson*.

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**Rejection Based on *Ludwig* in View of *Microsoft Press Computer Dictionary, Third Edition***

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* in view of *Microsoft Press Computer Dictionary, Third Edition* [hereinafter *Microsoft Press*].

Applicants submit that claim 24 is allowable as being based on allowable claim 14. In addition, *Microsoft Press* does not cure the deficiencies in *Ludwig* identified above. Claim 24 is therefore allowable over *Ludwig* in view of *Microsoft Press*.

**Rejection Based on *Ludwig* and *Walker* in view of *Axaopoulos et al.***

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* and *Walker* in view of *Axaopoulos et al.*, U.S. Pat. No. 6,286,002 [hereinafter *Axaopoulos*].

Applicants submit that claim 32 is allowable as being based on allowable claim 14 and allowable claim 27. In addition, *Axaopoulos* does not cure the deficiencies in *Ludwig* identified above, nor does it cure the deficiencies in *Walker* that were previously pointed out. Claim 32 is therefore allowable over *Ludwig* and *Walker* in view of *Axaopoulos*.

**Rejections Based on *Ludwig* in view of *Tannenbaum***

Claims 39 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* in view of *Tannenbaum*, Computer Networks, Second Edition [hereinafter *Tannenbaum*]. Applicants submit that claim 39 is allowable as being based on allowable claim 14. In addition, *Tannenbaum* does not cure the deficiencies in *Ludwig* identified above.

With respect to claim 41, the claim has been amended to point out with more particularity the nature of the invention claimed in claim 41. The amendment is similar to the amendment made to claim 14 in that the claim now demonstrates that the tools do not require a stand-alone installation on a client computer. Because *Ludwig* does not teach, suggest, or disclose selecting a plurality of web-accessible tools from a list of available web-accessible tools where the selected tools are provided through the web-based interface, claim 41 is allowable over *Ludwig*. Moreover, *Tannenbaum* does not cure these deficiencies in *Ludwig*. Accordingly, claim 41 is allowable.

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**Rejections Based on *Ludwig* and *Tannenbaum* in view of *Dictionary***

Claims 40 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Ludwig* and *Tannenbaum* in view of the *Dictionary of Computer and Internet Terms* [hereinafter *Dictionary*]. Applicants submit that claims 40 and 42 are allowable as being based on allowable base claims 14 and 41, respectively. In addition, *Dictionary* does not cure the deficiencies in *Ludwig* and *Tannenbaum* identified above. Claims 40 and 42 are therefore allowable over *Ludwig* and *Tannenbaum* in view of *Dictionary*.

**Conclusion**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733 accordingly.

All rejections having been addressed, applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: XXXX, xx, 2003

By:

***DRAFT***

Ross Dannenberg  
Reg. No. 49,024

1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Tel: (202) 824-3000  
Fax: (202) 824-3001